

Remarks/Arguments:

By this Amendment, Applicants' have amended claims 13 and 14, and added new claims 29 and 30. Claims 13-30 are pending.

Claim Objection

Claim 14 is objected to on informal grounds. Applicants have amended claim 14 to overcome the basis for this objection.

Claim Rejections Under Section 112

Claims 13 and 15-21 stand rejected under 35 USC § 112, second paragraph, as being indefinite for reasons set forth in numbered paragraphs 4 and 5 of the Office Action. Applicants have amended claim 13 to more clearly define the relationship between the second conductive pattern and the first conductive pattern and thereby overcome the basis for the section 112 rejection. Applicants contend that all pending claims are in full compliance with section 112.

Claim Rejections Under Section 103

Claims 13-28 stand rejected under 35 USC § 103(a) as being unpatentable over Hayama in view of Saitou. Based on this Amendment, applicants respectively traverse this Section 103(a) rejection.

Claim 13 is an independent claim to which claims 15-21 depend. Claim 14 is an independent claim to which claims 22-28 depend.

Turning first to independent claim 13, it is directed to a multilayer ceramic substrate including the following elements:

- **a ceramic substrate having a through hole with a conductive material therein,**
- a first conductive pattern having a convex via having a step, and being formed on the ceramic substrate by a transfer printing technology through an intagoio printing using a flexible resin substance,
- an insulation layer formed on the first conductive pattern, and

- **a second conductive pattern electrically connected to the first conductive pattern by the via, and the conductive material of the ceramic substrate being in contact with the via.**

It is applicants' contention that the multilayer ceramic substrate defined by claim 13 is patently distinguished from the Hayama Reference and Saitou Patent at least based on the requirement that the ceramic substrate has a through hole with a conductive material therein and the second conductive pattern is electrically connected to the first conductive pattern by the via, and the conductive material of the ceramic substrate is in contact with the via. This structure is neither defined nor suggested in the Hayama Reference and Saitou Patent. And it is applicants' contention that the combining of these references to teach the multilayer ceramic substrate of applicants claim to the invention is improper.

The Hayama Reference does show in Drawings 10 and 12 a substrate 2, and a substrate 31, respectively. But, there is simply no teaching or suggestion in the Hayama Reference of a ceramic substrate having a through hole with a conductive material therein and the conductive material of the ceramic substrate being in contact with the via of the first conductive pattern. The Office Action, appears to agree with this position of applicants. However, the Office Action goes on to combine the teaching of the Saitou Patent with the teaching the Hayama Reference to achieve applicants multilayer ceramic substrate as defined in claim 13. Applicants respectively disagree with this combination of references.

While the Saitou Patent does show at Figure 1, substrates 11 and vias 13, it is applicants' contention that there is simply no basis for combining Saitou with Hayama. In rejecting claims under 35 USC § 103, the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. If the Examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. *In re Rijckaert* 9 F.3d 1531, 1532 (Fed. Cir. 1993). A *prima facie* case of obviousness is established when the teaching from the cited reference itself would appear to have suggested the claimed subject matter to one skilled in the art. *In re Rijckaert* 9 F.3d 1531, 1532 (Fed. Cir. 1993). Obviousness cannot be established by combining the teaching of the references to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination. *In re Bond* 910 F.2d 831, 834 (Fed. Cir. 1990). *Accord, In re Rauffet* 1998 U.S. App. Lexis 16414 (Fed. Cir. 1998). It is applicants contention that there is simply no suggestion or motivation to one skilled in the art to combine these two references to teach applicants claimed invention. The combining of these

references is nothing more than hindsight reconstruction of applicants' claimed invention without the motivation or incentive for combining these references. Such combination is simply improper. It is applicants' position that one skilled in the art would not consider combining these references were it not for the teaching of applicants' claimed invention.

Based on the foregoing remarks, applicants respectfully submit that claim 13 and dependent claims 15-21 are in condition for allowance.

Claim 14 has been amended to include substantially the same features as noted above with respect to claim 13. Thus for the same reasons as discussed above, claim 14 and dependent claims 22-28 are neither anticipated nor obvious in view of the Hayama Reference and Saitou Patent. Applicants therefore request that the Section 103(a) rejection based on the Hayama Reference and Saitou Patent be withdrawn.

Newly Added Claims

Applicants have added new dependent claims 29 and 30. Claim 29 is directly dependent on claim 13, and claim 30 is directly dependent on claim 14.

Both claim 29 and claim 30 further describe the first conductive pattern on the ceramic substrate as being a transfer of an intaglio plate. It is applicants' contention that neither the Hayama Reference nor the Saitou Patent either teach or suggest a multilayer ceramic substrate where the first conductive pattern on the ceramic substrate is a transfer of an intaglio plate. This feature further distinguishes applicants' claimed invention from the references of record.

Applicants further submit that the addition of claims 29 and 30 is not the addition of new matter but is based on the application as originally filed. In addition, applicants discuss throughout the originally filed application the advantage achieved by a transfer of an intaglio plate in a multilayer ceramic substrate. Applicants contend that new claims 29 and 30 are patently distinguished over the references of record.

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In view of the forgoing remarks and amendments, applicants respectfully submit that claims 13-30 are in condition for allowance. Reconsideration and allowance of all pending claims are respectfully requested.

Respectfully submitted,

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